

### REMARKS

This communication responds to the Office Action mailed on September 20, 2005. Claims 1, 4-6, 8-9, 11-14, 16-18, 21-22, 24, 27, and 29 are amended, no claims are canceled, and no claims are added. As a result, claims 1-29 are now pending in this Application.

#### §103 Rejection of the Claims

Claims 4, 10-11 and 17-29 were rejected under 35 USC § 103(a) as being unpatentable over Mori et al. (U.S. 6,891,214; hereinafter "Mori") in view of Perner (U.S. 6,694,282; hereinafter "Perner"). Claims 1-3, 5-9, 12-15, 17, 21, 26 and 27 were rejected under 35 USC § 103(a) as being unpatentable over Mori in view of Goodfellow et al. (U.S. 2004/0150928; hereinafter "Goodfellow") and further in view of Perner. First, the Applicant does not admit that Mori, Perner, or Goodfellow are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established in each case with respect to the claims, the Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). In combining prior art references to construct a *prima facie* case, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *Id.* The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d (BNA) 1443

(Fed. Cir. 1992). However, while it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which notes that the motivation must be supported by evidence in the record.

It is respectfully noted that the claims have been amended to clarify that out-of-specification input operational conditions are recorded in the various embodiments, and not for reasons related to patentability. No new matter has been added. Thus, no proper *prima facie* case of obviousness has been established because combining the references does not teach all of the limitations set forth in the claims.

For example, with respect to independent claims 1, 8, 13, 17, and 28, no combination of Mori, Perner, or Goodfellow renders all of the claim limitations. Mori does not teach the presence of “storing at least one input operating over-voltage condition occurring in an integrated circuit in an indelible memory,” (claim 1) or “recording an out-of-specification input operating condition in an indelible memory,” (claims 4 and 12) or “an indelible memory to store a selected number of out-of-specification input operational conditions encountered by an electronic circuit,” (claims 17 and 22) as claimed by the Applicant. Neither do Perner or Goodfellow.

Mori describes storing over-current and over-temperature indications in a memory, perhaps using irreversible switches. See Mori Col. 7, lines 4-53 and Col. 10, lines 30-35. However, Mori does not teach storing an “input operating over-voltage condition” or any other type of “out-of-specification input operating condition”.

Perner describes storing calibration data, such as a lower and upper calibration temperature (preferably provided by an environmental oven) in a PROM during fabrication, or perhaps as read from an external location at some other time. See Perner, Col. 7, lines 37-62;

and Col. 9, lines 20-28. Counter values, related via the calibration data to temperature, may be read out of a register during operation. See Perner, Col. 6, lines 3-45. Thus, while Perner describes storing calibration data, and reading out temperature-related data, Perner does not teach storing temperatures in the PROM during circuit operation, or storing any type of an “out-of-specification input operating condition,” such as an input voltage.

Goodfellow describes storing threshold values, interchangeably termed “parameters” or “faults” in block the I/O Command Interface/Failure Detect 206. See Goodfellow, para. [0058] However, while fault conditions (i.e., excursions beyond the stored threshold values) may be detected by the state control and fault monitor 650, they are not stored. See Goodfellow, paras. [0056] and [0058]. Input conditions are not even monitored. Thus, Goodfellow also does not teach storing any type of an “out-of-specification input operating condition,” such as an input voltage.

Therefore, independent claims 1, 4, 12, 17, and 22 are nonobvious in view of Mori, Perner, and Goodfellow. This conclusion applies with even greater force respecting dependent claims 2-3, 5-11, 13-16, 18-21, and 23-29, since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03. It is therefore respectfully requested that the rejections of claims 1-29 under 35 U.S.C. § 103 be reconsidered and withdrawn.



### CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney Mark Muller at 210-308-5677, or the below-signed attorney to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9<sup>th</sup> day of November 2005.

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